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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,448	05/10/2005	Robert S. Silverman	O5PLI1344I	4778
24984	7590	09/28/2007		
ALBERT O COTA 5460 WHITE OAK AVE SUITE A-331 ENCINO, CA 91316			EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 09/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/534,448

Applicant(s)

SILVERMAN, ROBERT S.

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 10 and 82 are objected to because of the following informalities: Claim 10 should be dependent from Claim 9 and not Claim 10. Claim 82 should have the phrase "elastomeric polymer material" replaced with "silicone rubber". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4, 5, 12 –14, 17 – 19, 21, 22, and 26 – 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Maldonado (U.S. 5,013,068).

In regards to Claims 1 and 13 Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from an elastomeric polymer material 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141) wherein the cover is substantially of uniform thickness (Column 2, Lines 40 – 46; Figure 3).

In regards to Claim 4, as applied to Claim 1, Maldonado further discloses wherein the pocket portions are adapted to receive substantially all of the covers of the

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book (Column 3, Lines 25 – 26; Figure 3, Item 130; shows pockets cover most of the panel where the book panel will lay).

In regards to Claim 5, as applied to Claim 1, Maldonado further discloses wherein periphery edges (104 – 107) of the book cover are reinforced 110 (Column 2, Lines 47 – 50; Figures 4a & 5, Item 110).

In regards to Claim 12, as applied to Claim 1 (where Maldonado meets the structural limitations) and with respect to the book cover being molded; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In regards to Claim 14, as applied to Claim 1, Maldonado further discloses wherein peripheral edge (Examiner considers the peripheral edge anything outside of the non uniform thickness) portions of the book cover have at least one groove adapted to secure the book cover around the book perimeter (Figure 5, pinched ends help form a groove to receive the book).

In regards to Claim 17, as applied to Claim 1, Maldonado further discloses wherein the book cover includes at least one visual effect (Examiner considers a visual effect to also be an item of color or indicia since they make the item stand out).

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In regards to Claim 18, as applied to Claim 17, Maldonado further discloses wherein the book cover is colored (Column 2, Lines 56 – 68).

In regards to Claims 19 and 21, as applied to Claim 18, Maldonado discloses a multi material cover having multi colors (Column 2, Lines 56 – 68) and due to the colors the cover is opaque.

In regards to Claims 26 and 27, as applied to Claim 1, Maldonado further discloses wherein at least one surface of the book cover is textured considering the periphery is stitched and at a different level (Column 2, Lines 64 – 65; Figure 5) where both would help with gripping.

In regards to Claims 22 and 28, as applied to Claims 17 and 1, Maldonado further discloses wherein the book cover includes at least one visual indicia (Column 2, Lines 56 – 68; Day-Glo is a paint and not visible under ordinary light and therefore provides an effect when provided in different lighting; Furthermore any kind of paint or ink adding would be indicia and therefore an image).

In regards to Claim 29, as applied to Claim 1, Maldonado further discloses wherein the book cover is waterproof (Column 1, Lines 20 – 25; Column 2, Lines 25 – 31).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 15, 58, 61, 69 – 72, 74 – 77, 79, 84, 85, 87, 90, 91, 98, 100, 102 – 105, 107, 112, and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado.

In regards to Claim 15, as applied to Claim 1, Maldonado further discloses wherein the elastomeric material is selected from the group consisting of rubbers and latex (it is well known that neoprene is a type of synthetic rubber). It is also known that silicone rubber and latex are also synthetic rubbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Maldonado with a different synthetic rubber, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regards to Claim 58, 70 and 72, Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141) wherein the cover is substantially of uniform thickness (Column 2, Lines 40 – 46; Figure 3) and is made of a synthetic rubber 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101). It is also known that silicone rubber and latex are also synthetic rubbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Maldonado with a different synthetic rubber, because it has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regards to Claim 87 and 99, please refer to the rejection of Claims 58 and 70 since the claims are identical except for the latex limitation which is also addressed in the rejection.

In regards to Claim 61, as applied to Claim 58, please refer to the rejection of Claim 4.

In regards to Claim 62, as applied to Claim 58, please refer to the rejection of Claim 5.

In regards to Claim 69, as applied to Claim 58, please refer to the rejection of Claim 12.

In regards to Claim 71, as applied to Claim 58, please refer to the rejection of Claim 14.

In regards to Claim 74, as applied to Claim 58, please refer to the rejection of Claim 29.

In regards to Claim 75, as applied to Claim 58, please refer to the rejection of Claim 17.

In regards to Claim 76, as applied to Claim 75, please refer to the rejection of Claim 18.

In regards to Claim 77, as applied to Claim 76, please refer to the rejection of Claim 19.

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In regards to Claim 79, as applied to Claim 75, please refer to the rejection of Claim 21.

In regards to Claims 84 and 85, as applied to Claim 58, please refer to the rejection of Claims 26 and 27.

In regards to Claim 90, as applied to Claim 87, please refer to the rejection of Claim 4.

In regards to Claim 91, as applied to Claim 87, please refer to the rejection of Claim 5.

In regards to Claim 98, as applied to Claim 87, please refer to the rejection of Claim 12.

In regards to Claim 100, as applied to Claim 87, please refer to the rejection of Claim 14.

In regards to Claim 102, as applied to Claim 87, please refer to the rejection of Claim 29.

In regards to Claim 103, as applied to Claim 87, please refer to the rejection of Claim 17.

In regards to Claim 104, as applied to Claim 103, please refer to the rejection of Claim 18.

In regards to Claim 105, as applied to Claim 104, please refer to the rejection of Claim 19.

In regards to Claim 107, as applied to Claim 103, please refer to the rejection of Claim 21.



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In regards to Claims 112 and 113, as applied to Claim 87, please refer to the rejection of Claims 26 and 27.

3. Claims 2, 3, 8, 16, 30 – 33, 36, 40 – 47, 49, 54, 55, 57, 59, 60, 65, 73, 88, 89, 94 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado (U.S. 5,013,068) in view of Peker (U.S. 6,257,622).

In regards to Claim 2 and 3, as applied to Claim 1, Maldonado does not disclose wherein the pocket portions form a generally elliptically shaped access slot and wherein the access slot is adapted to be substantially aligned with and parallel to the spine of the book.

Peker discloses a book cover 4 where the pockets 12, 14 to hold the book cover have an elliptical shape wherein the pockets are substantially aligned with and parallel to the spine of the book (Column 4, Lines 22 – 33; Figure 5, Items 4, 12, 14). Applicant has failed to disclose the criticality of the pocket being elliptical. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide pockets of an elliptical shape since a change in shape would not change the operation or function of the device.

In regards to Claim 8, as applied to Claim 1, Maldonado does not disclose wherein edge portions of the access slot are reinforced.

Peker discloses a book cover 4 where pockets 12 and 14 are reinforced (Column 5, Lines 5 – 23). Therefore it would have been obvious to a person having ordinary skill in the art to provide a stitched material (as shown by Maldonado along periphery) in order to protect and reinforce the pockets adapted to receive the book covers.

In regards to Claim 16, as applied to Claim 2 Maldonado modified by Peker further discloses wherein the access slot includes a recess adapted (upon closing the cover) to engage top and bottom spine portions of the book (Figure 1; Maldonado). Furthermore a spine locking feature is present by means of the periphery.

In regards to Claims 30, 31, and 41, Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from an elastomeric polymer material 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141) wherein the cover is substantially of uniform thickness (Column 2, Lines 40 – 46; Figure 3).

Maldonado does not disclose wherein the pocket portions form a generally elliptically-shaped access slot.

Peker discloses a book cover 4 where the pockets 12, 14 to hold the book cover have an elliptical shape wherein the pockets are substantially aligned with and parallel to the spine of the book (Column 4, Lines 22 – 33; Figure 5, Items 4, 12, 14). Applicant has failed to disclose the criticality of the pocket being elliptical. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide pockets of an elliptical shape since a change in shape would not change the operation or function of the device.

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In regards to Claim 32, as applied to Claim 30, Maldonado modified by Peker further discloses wherein the pocket portions are adapted to receive of the covers of the book (Column 4, Lines 28 – 33; Peker; Column 3, Lines 25 – 26; Maldonado).

In regards to Claim 33, as applied to Claim 30, please refer to the rejection of Claim 5.

In regards to Claim 36, as applied to Claim 30, please refer to the rejection of Claim 8.

In regards to Claim 40, as applied to Claim 30, (wherein Maldonado modified by Peker meets the structural limitations) and with respect to the book cover being molded; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In regards to Claim 42, as applied to Claim 30, please refer to the rejection of Claim 14.

In regards to Claim 43, as applied to Claim 30, please refer to the rejection of Claim 15.

In regards to Claim 44, as applied to Claim 30, please refer to the rejection of Claim 16.

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In regards to Claim 45, as applied to Claim 30, please refer to the rejection of Claim 17. .

In regards to Claim 46, as applied to Claim 45, please refer to the rejection of Claim 18.

In regards to Claim 47, as applied to Claim 46, please refer to the rejection of Claim 19.

In regards to Claim 49, as applied to Claim 45, please refer to the rejection of Claim 21.

In regards to Claims 54 and 55, as applied to Claim 30, please refer to the rejection of Claims 26 and 27.

In regards to Claim 57, as applied to Claim 30, please refer to the rejection of Claim 29.

In regards to Claims 59 and 60, as applied to Claim 58, please refer to the rejections of Claims 2 and 3.

In regards to Claim 65, as applied to Claim 58, please refer to the rejection of Claim 8.

In regards to Claim 73, as applied to Claim 59, please refer to the rejection of Claim 16.

In regards to Claims 88 and 89, as applied to Claim 87, please refer to the rejection of Claims 2 and 3.

In regards to Claim 94, as applied to Claim 87, please refer to the rejection of Claim 8.

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In regards to Claim 101, as applied to Claim 88, please refer to the rejection of Claim 16.

4. Claims 6, 7, 63, 64, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado (U.S. 5,013,068) in view of Wong et al. (Wong; U.S. Pub. 2004/0066031).

In regards to Claim 6, as applied to Claim 5 Maldonado does not disclose wherein said periphery edges are reinforced by the material of the book cover being thicker thereat.

Wong discloses of reinforcement members, in an item to hold signatures wherein the reinforcement members are made from the original material of the object (Page 2, Column 1, Lines 1 – 6). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to obtain a reinforcing perimeter as taught by Wong in order to further strengthen the reinforcing methods of Maldonado (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claim 7, as applied Claim 6, Maldonado modified by Wong further discloses wherein said periphery edges are at least twice as thick as unreinforced portions of the book cover (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claim 63, as applied to Claim 62, please refer to the rejection of Claim 6.

In regards to Claim 64, as applied to Claim 63, please refer to the rejection of Claim 7.

In regards to Claim 92, as applied to Claim 91, please refer to the rejection of Claim 6.

In regards to Claim 93, as applied to Claim 92, please refer to the rejection of Claim 7.

5. Claims 9, 10, 34, 35, 37, 38, 66, 67, 95 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldonado (U.S. 5,013,068) in view of Peker (U.S. 6,257,622) and Wong et al. (Wong; U.S. Pub. 2004/0066031).

In regards to Claims 9 and 10, as applied to Claim 8, Maldonado modified by Peker does not disclose wherein said edge portions are reinforced by the material of the book cover being thicker thereat and wherein said edge portions are at least twice as thick as unreinforced portions of the book cover.

Wong discloses of reinforcement members, in an item to hold signatures wherein the reinforcement members are made from the original material of the object (Page 2, Column 1, Lines 1 – 6). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to obtain a reinforcing perimeter, as taught by Wong, and on the pocket area as taught by Peker in order to further strengthen the reinforcing methods of Maldonado (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claim 10, as applied to Claim 9, Maldonado modified by Peker and Wong further discloses wherein said edge portions are at least twice as thick as unreinforced portions of the book cover (Page 2, Column 1, Lines 1 – 6; Wong).

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In regards to Claim 34, as applied to Claim 33, Maldonado modified by Peker does not disclose wherein said periphery edges are reinforced by the material of the book cover being thicker thereat.

Wong discloses of reinforcement members, in an item to hold signatures wherein the reinforcement members are made from the original material of the object (Page 2, Column 1, Lines 1 – 6). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to obtain a reinforcing perimeter as taught by Wong in order to further strengthen the reinforcing methods of Maldonado in view of Peker (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claim 35, as applied Claim 34, Maldonado modified by Peker and Wong further discloses wherein said periphery edges are at least twice as thick as unreinforced portions of the book cover (Page 2, Column 1, Lines 1 – 6; Wong).

In regards to Claims 37, as applied to Claim 36, please refer to the rejection of Claim 9.

In regards to Claims 38, as applied to Claim 37, please refer to the rejection of Claim 10.

In regards to Claims 66, as applied to Claim 65, please refer to the rejection of Claim 9.

In regards to Claims 67, as applied to Claim 66, please refer to the rejection of Claim 10.

In regards to Claim 95, as applied to Claim 94, please refer to the rejection of Claim 9.

In regards to Claim 96, as applied to Claim 95, please refer to the rejection of Claim 10.

6. Claims 1, 11, 17, 20, 22 28, 58, 68, 75, 78, 80, 86, 87, 97, 103, 106, 108, and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning (5,207,717) in view of Maldonado (U.S. 5,013,068).

In regards to Claims 1 and 11, Manning discloses a book cover 10 comprising: an outside surface (Figure 1) and pocket portions 18, 19 (Column 3, Lines 3 – 6; Figure 2, items 18, 19) wherein the book cover is of unitary construction (Column 1, Lines 51 – 55).

Manning does not disclose the cover formed from an elastomeric polymer material an outside surface adapted to generally cover the exterior surfaces of a book and pocket portions adapted to receive at least a portion of the covers of the book

Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from an elastomeric polymer material 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the book cover of Manning with an elastomeric polymer material and larger pockets in order to allow the book cover to hold larger materials with ease.



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In regards to Claim 17, 22 and 28, as applied to Claim 1, Manning modified by Maldonado further discloses wherein the book cover includes at least one visual effect (Examiner considers a visual effect to also be an item of visible color or visible indicia since they make the item stand out and the indicia; Figure 1, Item Image; Manning).

In regards to Claim 20, as applied to Claim 17, Manning modified by Maldonado further discloses wherein the book cover can be transparent (Column 1, Lines 51 – 59; Manning).

In regards to Claims 58 and 68, Manning discloses a book cover 10 comprising: an outside surface (Figure 1) and pocket portions 18, 19 (Column 3, Lines 3 – 6; Figure 2, items 18, 19) wherein the book cover is of unitary construction (Column 1, Lines 51 – 55).

Manning does not disclose the cover formed from a silicone rubber and an outside surface adapted to generally cover the exterior surfaces of a book and pocket portions adapted to receive at least a portion of the covers of the book.

Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from a synthetic rubber 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140, 141). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the book cover of Manning with an synthetic rubber material and larger pockets in order to allow the book cover to hold larger materials with

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ease. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Maldonado with a different synthetic rubber, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

In regards to Claims 75, 78, 80, and 86, as applied to Claim 58, please refer to the rejections of Claims 17, 18, 20, 22 and 28.

In regards to Claim 87 and 97, please refer to the rejection of Claims 58 and 68 since the claims are identical except for the latex limitation which is also addressed in the rejection.

In regards to Claim 103, as applied to Claim 87, please refer to the rejection of Claim 17.

In regards to Claim 106, as applied to Claim 103, please refer to the rejection of Claim 20.

In regards to Claim 108, as applied to Claim 103, please refer to the rejection of Claim 22.

In regards to Claim 114, as applied to Claim 87, please refer to the rejection of Claim 28.

7. Claims 23 – 25, 81 – 83, and 109 – 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning (5,207,717) in view of Maldonado (U.S. 5,013,068) and Contello (U.S. 4,541,364).

In regards to Claims 23 and 24, as applied to Claim 17, Manning modified by Maldonado does not disclose wherein the book cover contains a plurality of reflective particles and wherein the reflective particles are suspended in the elastomeric polymer material.

Contello discloses an elastomeric material comprising light reflective flakes (Column 5, Lines 42 – 48). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the elastomeric material of Manning modified by Maldonado with the reflective flakes of Contello in order to provide a book cover with a necessary safety feature (Column 5, Lines 48 – 53 – Contello; Column 2, Lines 64 – 68 – Maldonado).

In regards to Claim 25, as applied to Claim 23, Manning modified by Maldonado and Contello discloses that the reflective flakes are embedded in the material (Column 5, Lines 42 – 48; Contello) and therefore are suspended in the material and also can be imprinted since embedding can just be an concavity in the surface of the material. Furthermore with respect to the act of imprinting; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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In regards to Claims 81 and 82 as applied to Claim 75, please refer to the rejection of Claims 23 and 24.

In regards to Claim 83, as applied to Claim 81, please refer to the rejection of Claim 25.

In regards to Claims 109 and 110, as applied to Claim 103, please refer to the rejection of Claims 23 and 24.

In regards to Claim 111, as applied to Claim 109, please refer to the rejection of Claim 25.

8. Claim 30, 39, 45, 48, 50, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning (5,207,717) in view of Maldonado and Peker.

In regards to Claims 30 and 39, Manning discloses a book cover 10 comprising: an outside surface (Figure 1) and pocket portions 18, 19 (Column 3, Lines 3 – 6; Figure 2, items 18, 19) wherein the book cover is of unitary construction (Column 1, Lines 51 – 55).

Manning does not disclose formed from an elastomeric polymer material an outside surface adapted to generally cover the exterior surfaces of a book and pocket portions adapted to receive at least a portion of the covers of the book

Maldonado discloses a book cover 10 (Column 2, Lines 22 – 23) formed from an elastomeric polymer material 101 (Column 2, Lines 25 – 31; Figure 4a, Item 101), comprising: an outside surface adapted to generally cover the exterior surfaces of a book 11 (Figure 1, Items 10, 11); and pocket portions 140, 141 adapted to receive at least a portion of the covers of the book (Column 3, Lines 10 – 17; Figure 3, Items 140,

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141) wherein the cover is substantially of uniform thickness (Column 2, Lines 40 – 46; Figure 3).

Maldonado does not disclose wherein the pocket portions form a generally elliptically-shaped access slot.

Peker discloses a book cover 4 where the pockets 12, 14 to hold the book cover have an elliptical shape wherein the pockets are substantially aligned with and parallel to the spine of the book (Column 4, Lines 22 – 33; Figure 5, Items 4, 12, 14). Applicant has failed to disclose the criticality of the pocket being elliptical. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide pockets of an elliptical shape since a change in shape would not change the operation or function of the device.

In regards to Claim 45, 50, and 56, as applied to Claim 30, please refer to the rejection of Claim 17.

In regards to Claim 48, as applied to Claim 45, please refer to the rejection of Claim 20.

9. Claims 51 – 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning in view of Maldonado, Peker and Contello.

In regards to Claims 51 and 52, as applied to Claim 45, Manning in view of Maldonado and Peker does not disclose wherein the book cover contains a plurality of reflective particles and wherein the reflective particles are suspended in the elastomeric polymer material.

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Contello discloses an elastomeric material comprising light reflective flakes (Column 5, Lines 42 – 48). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the elastomeric material of Manning modified by Maldonado with the reflective flakes of Contello in order to provide a book cover with a necessary safety feature (Column 5, Lines 48 – 53 – Contello; Column 2, Lines 64 – 68 – Maldonado).

In regards to Claim 53, as applied to Claim 51, please refer to the rejection of Claim 25.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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September 24, 2007

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